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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,955	03/11/2004	Timothy D. Killinger	29618/39225D	7721
4743 7590 08/20/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER				
NEWTON, JARED W				
ART UNIT		PAPER NUMBER		
3693				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,955

**Applicant(s)**

KILLINGER ET AL.

**Examiner**

JARED W. NEWTON

**Art Unit**

3693

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-8 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This final rejection is in reply to the remarks filed April 14, 2008, by which claim 1 was amended, claims 12-21 were cancelled, and claims 22-26 were added. Claims 1, 2, 4-8 and 22-26 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-8, and 22-26 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regard to claim 1, the following recitation is not supported by the specification as originally filed:

- "the front wall having an aperture therein" (line 3); and
- "and laterally extending hooks of the hanging file maintain direct contact with . . . no other surface regardless of whether the openable panel is in the retracted condition or the open condition" (lines 25-28).

The noted limitations should be canceled from the claim or the Applicant should provide a detailed explanation of how the limitations are supported by the disclosure as originally filed.

Claims 2, 4-8, and 22-26 are rejected under this section because they depend from claim 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 25, the word "may" in line 1 renders the claim indefinite because one of ordinary skill in the art at the time of the invention would not be able to ascertain whether the recitation following the term is required.

#### ***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4-8, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,505,388 to Solomon.

In regard to claim 1, Solomon discloses an expandable filing system comprising: an exterior shell 10 having a front wall (the frontmost portions of walls 12 and 14), a pair of opposing, laterally spaced side walls 12 and 14, each having an outer surface (see FIGS. 1 and 2); an openable panel 16 defining part of the exterior shell, the openable panel having a bottom edge 32, a forward facing surface, and a rear facing surface (see

FIG. 2), the openable panel 16 being pivotal about the bottom edge 32 outward from the exterior shell between a retracted condition (see FIG. 2) at which the forward facing surface is generally flush with the outer surface of the front wall of the exterior shell and an open condition 34 (see FIG. 2, phantom) away from the outer surface of the front wall of the exterior shell; and

a file support structure (see Abstract, ln. 14-15) capable of suspending a file at any position along its length when the openable panel is in the open condition, said structure having a file storage area, an open top for insertion, access to, and removal of files from the file storage area, a pair of panels 66 extending rearward from the rear facing surface of the openable panel defining in part the file storage area, and a file suspension device (upper edges of panels 66—see col. 2, ln. 55-65) provided to suspend files completely within the file storage area, the file support structure disposed adjacent to the rear facing surface of the openable panel and being movable in concert with the openable panel (see FIG. 2), wherein the open top is accessible when the openable panel is in the open condition (see FIG. 2, phantom) and wherein the file support structure is disposed within the exterior shell when the openable panel is in the retracted condition (see FIG. 2). Solomon further discloses said openable panel as pivotable between the open condition and the retracted condition without moving top panel 22 (see FIG. 2).

Solomon further discloses the file support structure as configured such that a file disposed on the file suspension device is completely disposed between outer surfaces of the first and second panels (see FIG. 3).

Solomon further discloses the file suspension device including a pair of laterally spaced apart curved suspension surfaces, one of the curved suspension surfaces disposed along an upper edge of a respective one of the first and second panels.

Solomon further discloses a panel portion of a file folder as disposed substantially between outer surfaces of the first and second panels and laterally extending hooks of the file maintaining direct contact with the curved suspension surfaces and no other surfaces (see FIG. 3).

In regard to claim 4, Solomon further discloses the pair of suspension surfaces arranged to present files suspended in the file storage area in a forwardly and downward cascading arrangement (see FIG. 2, phantom).

In regard to claim 5, Solomon further discloses each pair of suspension surfaces as arched (see FIG. 2).

In regard to claims 6 and 7, Solomon further discloses the exterior shell comprising a top panel 22 providing a generally horizontal support surface in the form of a table when the openable panel is in the retracted position (see FIG. 2).

In regard to claim 8, Solomon further discloses the exterior shell and the openable panel 16 as combinable to form a configuration that hides the file storage area of the storage device when the openable panel is in the closed condition (see FIG. 2).

In regard to claim 22, Solomon further discloses each curved suspension surface as curved convexly upward.

***Claim Rejections - 35 USC § 103***

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,505,388 to Solomon as applied to claims 1-8 above, and further in view of US Patent No. 4,666,047 to Fletcher.

Solomon discloses the expandable filing system as set forth above, including all of the limitations of claim 1. Solomon does not specifically set forth the file suspension supports (shown as the upper edges of panels 66) as having a series of notches. Fletcher discloses a hanger support for filing cabinets comprising: frame members 26 and 28 for supporting stationary rails 18 and 20, said rails adapted for receiving suspension rails 50 and 52 for supporting file hangers (see FIGS. 1 and 6). Fletcher further discloses each of said stationary rails comprising a plurality of notches 44 (see FIG. 1), wherein said notches retain said suspension rails, and thus said file hangers. The notches disclosed by Fletcher define a serpentine surface having a multiplicity of peaks and valleys that maintain spacing between hanging folders suspended from the file suspension device. The notches of Fletcher further define a sawtooth shape. The Solomon and Fletcher references are analogous art because they are from the same field of endeavor—file suspension devices. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the notches as disclosed by Fletcher on the upper edges of the panels as disclosed by Solomon. The motivation would have been that as set forth by Fletcher—to maintain files in a spaced relationship (see Fletcher, col. 4, ln. 4-15). It would be an obvious and successful improvement to

the upper shoulders of the panels 66 of Solomon, to provide said shoulders with evenly spaced notches, in order to maintain files in an evenly spaced and orderly manner.

In regard to claims 24 and 25, Solomon discloses a stop portion defined by slot 64.

Claim 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,505,388 to Solomon as applied to claims 1-8 above, alone.

In regard to claim 26, Solomon does not disclose wheels. It would have been obvious to one of ordinary skill in the art to provide the device disclosed by Solomon with wheels, in order to make the device more mobile. Such an improvement was a well-known means for improving the mobility of a storage device at the time of the invention.

### ***Response to Arguments***

In view of the Amendments filed April 14, 2008, the rejections under 35 U.S.C. §112 1<sup>st</sup> Paragraph set forth in the Office Action mailed January 15, 2008 are hereby withdrawn.

Applicant's arguments filed April 14, 2008 have been fully considered but they are not persuasive. Applicant's arguments have been addressed via the claim rejections above.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED W. NEWTON whose telephone number is (571)272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

JWN  
July 23, 2008